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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,741	07/03/2003	John C. S. Koo	31045-101	5633

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EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

MAIL DATE	DELIVERY MODE
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09/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/613,741

Applicant(s)

KOO, JOHN C. S.

Examiner

Jila M. Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8, 10-20 and 24-36 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Shin 4,658,514 in view of Root 2,793,136. Shin '514 teaches a shoe comprising a bottom surface that is adjacent to the ground in normal use and that the sole of a shoe has a plurality of protrusions 76 and a plurality of indentations (slots 50, see col. 3, lines 10-23) with only the protrusions having ridges 78 applied thereto to aid in affording traction to the user. Shin '514 further teaches that the indentations (slots 50) are provided to act as hinges and allow bending of the sole. Shin '514 shows these indentations without any traction elements because this section does not touch the ground and the traction elements would prevent complete bending of the sole in these areas. Shin '514 does not appear to disclose having a plurality of small particles

bonded to at least the lower portions of the protrusions. Root '136 discloses that it is desirable to bond a plurality of small articles to the bottom of shoe in place of ridges to provide better slip-resistant surface. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to replace the ridges on the lower extending portions of the protrusions of Shin '514 with the adhesively bonding small particles as taught by Root '136 to provide better slip-resistant surface. "A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int 'l v. Teleflex Inc.*, 127 S.Ct. 1731, 82 USPQ2d at 1396. "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *Id.*

Shin '514 as modified by Root '136 will have at least 1,000 small particles bonded to the at least some lower extending portions (see column 5, lines 34-58 of Root '136); the small particles are bonded to the at least some of the lower extending portions using adhesive material; the small particles comprises a fabric material (see column 4, lines 49-51 of Root '136); the small particles have been bonded directly onto the at least some of the lower extending portions; the sole is sufficiently durable for commercially acceptable outdoor use (see col. 2, lines 20-31); the sole includes an outsole that is comprised of solid rubber or other wear-resistant material; the small particles cover at least 50% of the portion of the bottom surface that normally comes into contact with the ground (see Figure 3A of Shin ' 514 where the ridges are replaced

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with plurality of small particle bonded there on); the sole is sufficiently strong for commercially acceptable outdoor use (see col. 2, lines 59-61 of Shin '514); the bottom surface has at least five indentations (see Figures 1 and 3A of Shin '514); at least some of the indentations are very narrow (see Figure 2 of Shin '514); at least one of the indentations appears to be approximately 1-2 millimeters in width (see indentations in forefoot area); at least some of the indentations are closely spaced (see First two indentations at front part of the toe area in Figure 2 of shin '514); at least two of the indentations appear to be separated from each other by no more than approximately 2 millimeters. Furthermore, it would have been an obvious matter of design choice to modify the size of the indentations, since such a modification would have involved a mere change in the size of a component. "[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1740, 82 USPQ2d 1396 (2007). A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

With respect to claims 4 and 32, Root '136 discloses embedding the small particles directly into said bottom surface using heat (see column 5, lines 50-58).

With respect to claims 4, 6 and 35, the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is

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the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

With respect to claims 8 and 10, see column 5, lines 8-10 of Root '136.

The references as applied to claim 1 above disclose all the limitations of the claims except for the for the particle material being made of natural or synthetic leather, natural or synthetic rubber, plastic, Root '156 discloses that a variety of particles can be used for forming the slip resistant surfaces. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to make the particles of the references as applied to claim 1 out of natural or synthetic leather, natural or synthetic rubber, or plastic as these materials are well known and used in the art for aiding in slip prevention.

With respect to claims 13-18, it appears that the ASTM tear resistance and abrasion resistance requirements are standards, therefore, it would be well within the skill of one of ordinary skill in the art to make a sole to meet these requirements. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the sole of the references as applied to claim 1 above meet the tear and abrasion resistance standards.

4. Claim 9 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above and further in view of Bible 4,779,360. Shin-

Root as modified above discloses all the limitations of the claim except for the particles comprising metal. Bible '360 teaches that grit material used to gain grip on slippery surfaces can be made of aluminum oxide, silicon carbide or tungsten carbide (i.e. metals) for their durability, less tendency to crumble and their hardness to scratch or furrow up metallic slippery surfaces. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the grit particles of Shin-Root as applied to claim 1 above out of metal, as taught by Bible '360, to aid in gaining grip on metallic or rough surfaces.

5. Claims 21-23 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claim 1 and further in view Schaffer et al. 5,276,981. Shin-Root as modified above discloses all the limitations of the claims except for the particle wearing off over certain time frames. Schaffer et al. '981 teaches that the material for particles attached to the bottom of shoe soles to aid in gaining traction can be modified to wear over given time frames, including weeks (see col. 2, lines 3-21). Therefore, it would have been well within the skill of one of ordinary skill in the art, to modify the material of the particles attached to the sole of Shin-Root as applied to claim 1 above to last over any time period desired, as taught by Schaffer et al. '981, to determine the wear life of the sole of the shoe.

Response to Arguments

6. Applicant's arguments filed 08/21/2007 have been fully considered but they are not persuasive. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

"[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1740, 82 USPQ2d 1396 (2007). A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
September 21, 2007